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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 13

Application Number: 09/189,250
Filing Date: November 10, 1998
Appellant(s): SILVESTER, KELAN C.

Timothy N. Trop
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/19/02.

(1)   Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2)   *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or

be directly affected by or have a bearing on the decision in the pending appeal is contained in the

brief.

(3)   *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4)   *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in

the brief is correct.

(5)   *Summary of Invention*

The summary of invention contained in the brief is correct.

(6)   *Issues*

The appellant's statement of the issues in the brief is correct.

(7)   *Grouping of Claims*

Appellant's brief includes a statement that the claims stand or fall together and provides

reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8)   *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9)   *Prior Art of Record*

| 5,742,905 | Pepe et al. | 4-1998 |
| 5,568,540 | Greco et al. | 10-1996 |

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 26-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Pepe et al.** (US 5,742,905) in view of **Greco et al.** (US 5,568,540).

As to Claim 26, with respect to Figures 31-36, **Pepe** teaches a method comprising:

identifying information about the source of a telephonic message (Col. 20, lines 43-44);

selecting a portion of said message (Col. 20, lines 50-54);

converting said portion to text (Col. 19, lines 43-44);

exporting said portion and said source information into a graphical user interface that displays a log of telephone calls including the source information and information about the subject matter of the message (Col. 20, lines 43-54, Col. 28, lines 15-18 and 35-40 and Col. 35, lines 30-50); and

Pepe does not teach the following limitation:

"displaying said portion in said graphical user interface including displaying the source of said message using said portion to indicate information about the subject matter of the message"

Greco teaches the limitation (Figure 2). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add subject display capability to **Pepe's** invention for displaying call subject as taught by Greco's invention in order to provide a user with call screening notification based on call subject.

As to Claims 27,38, **Pepe** teaches the method of claim 26 wherein identifying information about the source of a telephonic message includes using a caller identification device (Col. 16, lines 7-8).

As to Claims 28,33, **Pepe** teaches the method of claim 26 wherein selecting a portion of said message includes selecting the initial portion of said message of a size sufficient to fit within an available field within said graphical user interface (Figure 31, label 632).

As to claims 29,34, **Pepe** teaches the method of claim 26:

> **Pepe** does not teach the following limitation:

>> "wherein exporting said portion and said source information into a graphical user interface includes exporting said portion and said source information in a fashion that the portion may be provided under a heading indicating the source of the telephone call and said portion is displayed under a heading that indicates the subject matter of the telephone call"

> **Greco** teaches the limitation (Figure 2). Having the cited art at the time the invention

was made, it would have been obvious to one of ordinary skill in the art to add subject display capability to **Pepe's** invention for displaying call subject heading as taught by **Greco's** invention in order to provide a user with call screening notification based on call subject.

As to Claims 30,35, **Pepe** teaches the method of claim 28 including exporting said portion and said source information into a graphical user interface that also lists received e-mail messages (Figures 31 and 33).

As to Claims 31,36, **Pepe** teaches the method of claim 30 including exporting said portion and

said source information into a graphical user interface that indicates e-mail messages and

provides the source of the e-mail messages and the subject matter of the e-mail messages (Col.

35, lines 43-51).

As to claims 32, 37, with respect to Figures 31-36, **Pepe** teaches a PCI server (an article)

comprising a user profile (medium) storing instructions that enable a processor-based system to:

> identify information about the source of a telephonic message (Col. 20, lines 43-44);

> select a portion of said message (Col. 20, lines 50-54);

> convert said portion to text (Col. 19, lines 43-44);

> export said portion and said source information into a graphical user interface that displays

a log of telephone calls including the source information and information about the subject

matter of the message (Col. 20, lines 43-54, Col. 28, lines 15-18 and 35-40 and Col. 35, lines 30-

50); and

> > **Pepe** does not teach the following limitation:

> > "display said portion in said graphical user interface including displaying the source of
> > said message and using said portion to indicate information about the subject matter of
> > said message"
> > **Greco** teaches the limitation (Figure 2). Having the cited art at the time the invention was

made, it would have been obvious to one of ordinary skill in the art to add subject display

capability to **Pepe's** invention for displaying call subject heading as taught by **Greco's** invention

in order to provide a user with call screening notification based on call subject.

(11)   Response to Argument

(a) The Examiner has directed Applicant to Col. 19, lines 43-44 **Pepe** for teaching

converting a portion of a telephonic message to text. This section does not teach converting a

voice mail or a portion of a voice mail to text. In addition, nowhere else in **Pepe** is there a

teaching of converting a portion of a voice mail to text.

Examiner respectfully disagrees because of the following:

(i) First, in the 9/14/01 Advisory, Examiner explained that Col. 19, lines 43-44

must be taken in context with all the other cited sections given in the rejection of Claim 26.

Examiner's response to Applicant's Remarks in the Advisory is reproduced below:

> "Col. 19, lines 43-44 does not teach converting a portion of a telephonic
> message to text.
> Examiner respectfully disagrees. The cited portion should be taken in
> context with the previously cited section at Col. 20, lines 50-54 and the section at Col. 20, lines
> 43-54, cited afterwards. Col. 20, lines 50-54 teaches a subject portion of a voice mail message.
> Col. 20, lines 43-54 teaches that crossmedia notification of the subject portion is sent to the PDA
> via E-mail. Col. 19, lines 43-44 teaches delivery of E-mail (text) to the PDA. Therefore, Col.
> 19, lines 43-44 teaches receiving E-mail notification of a subject portion of a voice message and
> which subject portion had to have been converted to text for it to be received at the PDA."

(ii) Second, in the 10/15/01 Advisory, Examiner further explained how **Pepe**

converts portions of voice mail messages. Examiner's response to Applicants' Remarks is

reproduced below:

> "**Pepe's** Col. 20, lines 42-53 does not teach converting a subject portion
> of a voice mail to text. This is because **Pepe's** Col. 27, lines 62-66 and Col. 28, lines 15-23 do
> not also teach a subject portion.
>
> Examiner agrees that the passages at Cols. 27 and 28 do not teach a
> subject portion. However, these passages do not exclude a subject portion as taught in the

passage at Col. 20. The body of an e-mail notification message is taught at Col. 20. In the body, the message that was received could be voice mail or any other type (Col. 20, lines 49-50). Part of this body is a subject. Therefore, as argued by Examiner before, this passage teaches converting a subject portion of a voice mail message to text and the argument that the phrase "if appropriate" refers only to converting an e-mail subject to voice format is not convincing.

Pepe suggests that the inclusion of the subject is based on parameters in a subscriber's profile (Col. 28, lines 15-18). Pepe teaches that text notification of received voice messages can be performed if such notification is in a subscriber's profile (Col. 28, lines 33-40). At Col. 28, lines 41-46, Pepe teaches screening voice messages for priority information. Priority information is part of the notification body in the teachings at Col. 20. Therefore, the passage at Col. 20, does teach that an e-mail notification of a received voice message contains priority information and subject information if appropriate"

(b) Applicant is not convinced that the cited passages of Pepe and Examiner's explanations

in the Advisories show that Pepe teaches converting a voice mail subject into text. In particular,

Applicant has re-emphasized the teachings of Pepe at Col. 27, lines 62-66 and Col. 28, lines 15-

23 as justification that Pepe does not teach converting a subject portion of a voice mail message

to text.

A close reading of the passages at Col. 27 and Col. 28 and in the context of related

teachings at Col. 27, lines 22-28 show that the lack of subject information is apparently due to

the use of the AMIS-Analog Protocol. Pepe also teaches an AMIS-Digital Protocol. It is with

this digital protocol that urgency of voice messages can be detected and sent in the e-mail

notifications to subscribers as taught at Col. 28, lines 41-46 and Col. 20, lines 41-53. This

urgency is equivalent to subject as will be further explained.

To better convince Applicant it is necessary to see how the disclosure defines "subject".

The disclosure, at Page 6, lines 18-26 and Figures 3-4, teaches the following:

"if the message is accepted, the message is recorded and stored as indicated at block
314. The message is then converted from speech-to-text for application display as indicated at
block 316. Thus, at least a portion of the message, together with the identify of the caller may be

converted into a text format for display on a graphic user interface. The graphical user interface may provide sufficient information so that the user can determine the nature of the call and can determine how to respond (see also, related passages at Page 8, lines 10-24 and Page 10, lines 3-9)"

This passage and Figure 4 of the disclosure teach that a subject portion relates to the <u>nature</u> of a call. In particular, Figure 4, label 408 of the disclosure teaches that the portion of a voice mail message that's converted to text includes "From", "subject" and "Received" sub-portions.

Examiner, respectfully believes that **Pepe's** Col. 20, lines 42-53 teaches PDA notification of voice mail receipt and which notification is equivalent to the claimed portion of a voice mail message that's converted to text. This is because the "sender's address", "date and time" and "urgent" sub-portions of the notification is equivalent to the "From", "Received" and "Subject" sub-portions of the disclosed voice mail portion that's converted to text. In particular, **Pepe's** "urgent" sub-portion is equivalent to the claimed "subject" portion because it provides information on the <u>nature</u> of a call.

Furthermore, **Pepe** teaches voice mails are marked urgent by senders (Col. 28, lines 41-42). At Col. 35, lines 43-51 and in the process of screening e-mails, **Pepe** teaches that subjects may include "urgent", "personal", etc. Therefore, "urgency" is a subject and the passage at Col. 20, lines 42-53 and with regards to the statement "and, if appropriate, the subject of the message" is not only related to detecting subject portions of e-mails but also to voice mails as well. Thus, based on **Pepe's** teachings "urgency" is a subject. Based on the disclosure, "urgency" is a subject because it gives information to a user on the <u>nature</u> of a call.

(c) Nowhere in **Pepe** or **Greco** is there a teaching of converting a portion of a voice mail to text.

Examiner respectfully disagrees for the same reasons given in Examiners responses in (a)-(b) above. **Pepe** teaches an e-mail notification that contains information on a voice mail portion that is converted to text. At Col. 28, lines 47-52, **Pepe** teaches conversion of voice formats (voice mail) to X.400 formats (e-mail text). **Pepe** teaches receiving voice mail or voice mail information and sending an e-mail notification of the received voice mail information (Col. 27, lines 29-33, 43-46, 54-58 and Col. 28, lines 15-18). Col. 11, lines 40-54 teaches that the X-400 formats are text formats that's used in e-mails. These passages teach that voice mail notification information is a portion of a voice mail that is converted to text and sent by e-mail for display on a user's PDA (see also Col. 5, lines 17-20).

Examiner only used **Greco** to teach the display of voice mail notification information and believes that it would be obvious to combine **Greco** with **Pepe** in order to display **Pepe's** notification information to user's.

(d) With respect to **Pepe's** Col. 20, lines 42-53, the language at lines 52-53, "if appropriate, the subject of the message" refers to an e-mail subject. This is because at Col. 28, lines 15-23 and Col. 27, lines 62-66 **Pepe** specifically teaches that subject information is not included in voice mail notifications.
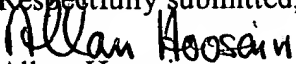
Examiner respectfully disagrees for the same reasons given by Examiner in (b) above.

12. Conclusion:

Examiner respectfully believes that a faithful attempt was made to address Applicant's concerns and show that **Pepe** does teach converting a portion of a voice mail to text during the prosecution of the Application. Examiner believes that the responses to Applicant's concerns in the Brief given in (a)-(d) above will convince the Board that **Pepe** does teach converting a

portion of a voice mail message into text and that it would have been obvious to combine **Greco**

with **Pepe** for displaying the converted information. For the above reasons, it is believed that the

rejections should be sustained.

Respectfully submitted,

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